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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,394	09/10/2003	Patrick Mailliet	03806.0491-01	2263

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EXAMINER

JARRELL, NOBLE E

ART UNIT	PAPER NUMBER
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1609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/658,394

Applicant(s)

MAILLIET ET AL.

Examiner

Noble Jarrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 22-24, 27-33, drawn to compounds and compositions comprising formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is pyrimidine, classified in class 544, subclass 242.
 - II. Claims 22, 27-33, drawn to compounds and compositions comprising formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is a carbonyl group, classified in class 546, subclass 26.
 - III. Claims 22, 27-33, drawn to compounds and compositions comprising formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is a group $C(=NH)-NH-C(=NH)$, classified in class 546, subclass 26.
 - IV. Claims 22, 27-33, drawn to compounds and compositions comprising formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is an alkylidyl group containing 3 to 7 carbon atoms, classified in class 546, subclass 26.
 - V. Claim 25, drawn to a method of inhibiting telomerase using formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is pyrimidine, classified in class 514, subclass 247.
 - VI. Claim 25, drawn to a method of inhibiting telomerase using formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is a carbonyl group, classified in class 514, subclass 279.

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- VII. Claim 25, drawn to a method of inhibiting telomerase using formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is a group $C(=NH)-NH-C(=NH)$, classified in class 514, subclass 279.
- VIII. Claim 25, drawn to a method of inhibiting telomerase using formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is an alkylidyl group containing 3 to 7 carbon atoms, classified in class 514, subclass 279.
- IX. Claim 26, drawn to a method of treating a cancer using formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is pyrimidine, classified in class 514, subclass 247.
- X. Claim 26, drawn to a method of treating a cancer using formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is a carbonyl group, classified in class 514, subclass 279.
- XI. Claim 26, drawn to a method of treating a cancer using formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is a group $C(=NH)-NH-C(=NH)$, classified in class 514, subclass 279.
- XII. Claim 26, drawn to a method of treating a cancer using formula I wherein the nitrogen-containing aromatic ring and the aromatic ring are both quinoline and the distribution agent is an alkylidyl group containing 3 to 7 carbon atoms, classified in class 514, subclass 279.
2. Inventions I-IV are patentably distinct products. Inventions are patentably distinct if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions each have a different definition for "distribution agent". The inventions are also classified differently because

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of the different definitions of “distribution agent”. The following table shows the different definitions and classifications of inventions I-IV.

<u>Invention Number</u>	<u>Distribution Agent</u>	<u>Class / Subclass</u>
I	Pyrimidine	544 / 242
II	Carbonyl	546 / 26
III	C(=NH)-NH-C(=NH)	546 / 26
IV	alkyldiyl group containing 3 to 7 carbon atoms	546 / 26

Because of the different definitions of “distribution agent” and the different classifications, an undue search burden exists to search all of the inventions.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

4. Inventions I-IV and (V-VIII or IX-XII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case telomestatin can be used to inhibit telomerase and taxol can be used to treat a cancer.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

6. Inventions VI-VIII and IX-XII are patentably distinct processes of use. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different

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inventions each have different use. Inventions V-VIII are used for inhibiting telomerase and inventions IX-XII are used for treating cancers. Even though telomerase is used as a therapeutic target for cancers sometimes, cancer is not always the target disorder when inhibiting telomerase. Therefore, these groups are mutually exclusive.

7. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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10. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noble Jarrell whose telephone number is (571) 272-9077. The examiner can normally be reached on Monday-Friday from 7:30 to 5:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Andrew Wang or Cecilia Tsang, can be reached on (571) 272-0811 or (571) 272-0562, respectively. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NJ


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